

II. Rejection under 35 U.S.C. § 103(a)

Claims 1-281, 286, and 288-299 have been rejected under 35 U.S.C. § 103(a) as unpatentable over U.S. Patent No. 5,302,378 ("Crotty") in view of U.S. Patent No. 5,783,657 ("Pavlin") and further in view of U.S. Patent No. 6,165,454 ("Patel") for the reasons set forth on pages 3-4 of the present Office Action. Applicants respectfully traverse this rejection.

Two of the basic criteria an Examiner must demonstrate in order to establish a *prima facie* case of obviousness are (1) that there is some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings, and (2) that there is a reasonable expectation of success in making the proposed modification. See M.P.E.P. § 2143. Neither of these two criteria has been satisfied with respect to the modifications of *Crotty* proposed by the Examiner.

With respect to the first criterion, the Federal Circuit has recently stated that:

[t]he factual inquiry whether to combine references must be thorough and searching. It **must be based on objective evidence of record...** Thus the Board must not only assure that the requisite findings are made, based on evidence of record, **but must also explain the reasoning by which the findings are deemed to support the agency's conclusion.**

See *In re Lee*, 61 U.S.P.Q.2d (BNA) 1430 (Fed. Cir. 2002) (emphasis added). Further,

"[t]o establish obviousness based on a combination of the elements disclosed in the prior art, there must be some motivation, suggestion or teaching of the desirability of making the specific combination that was made by the applicant." *In re Kotzab*, 217 F.3d 1365, 1371, 55 U.S.P.Q.2d (BNA) 1313 (Fed. Cir., 2000). Even when obviousness

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is based on a single prior art reference, there must be such a showing. See *B.F.*

Goodrich Co. v. Aircraft Braking Sys. Corp., 72 F.3d 1577, 1582, 37 U.S.P.Q.2D (BNA) 1314, 1318 (Fed. Cir. 1996). Accordingly, the requirements discussed in *In re Lee* are equally applicable in cases where the Examiner proposes to modify a single reference. Moreover, the mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. See M.P.E.P. § 2143.01.

In the present case, the Examiner has failed to make a factual inquiry based on any objective evidence of record. Such an inquiry would reveal that there would have been no motivation to make the proposed modifications at the time the invention was made, as discussed below.

Specifically, Crotty's compositions comprise a C₃-C₂₄ α-hydroxy substituted ketone or aldehyde, an anionic silicone copolyol, and a pharmaceutically acceptable vehicle. See col. 2, lines 22-29. The Examiner states that Crotty's "[c]omposition includes, sodium carboxyl methylcellulose, hydroxyalkyl cellulose etc. (col. 4, lines 49-61), polyethylene and polyamides (col. 5, line 33)." See page 3 of the present Office Action. The Examiner then concludes that "Crotty does not specifically mention the polymer of instant claim 28, and gum of instant claim 64." *Id.*

However, contrary to the Examiner's implication that Crotty satisfies all elements of the claims other than "the polymer of instant claim 28, and gum of instant claim 64," substantial picking and choosing would be required in order to arrive at the presently claimed invention. Crotty merely discloses numerous optional ingredients, such as (1) propylene glycol; (2) dihydroxyacetone; (3) indole derivatives; (4) pharmaceutically

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acceptable vehicles; (5) thickeners/viscosifiers; (6) emulsifiers; (7) surfactants; (8) fatty acids; (9) sunscreen agents; (10) preservatives; (11) fragrances; (12) antifoam agents; (13) opacifiers; and (14) colorants. See col. 3, line 5 through col. 5, line 66. Notably, Crotty does not disclose or exemplify compositions comprising "sodium carboxyl methylcellulose, hydroxyalkyl cellulose..., polyethylene [or] polyamides," and there is no teaching in the reference that would lead one of ordinary skill in the art to such a composition. Thus, one of ordinary skill in the art would not have been motivated to pick and choose the particular combination of components as presently claimed at least for the reason that *Crotty* does not teach or suggest the desirability of doing so. Moreover, the Examiner has not provided any motivation, suggestion, or teaching of the desirability of making the specific combination of the presently claimed invention as required by *In re Lee*.

Further, even if, arguendo, one of ordinary skill in the art would have been motivated to pick, choose, and combine various optional ingredients such as hydroxyalkyl cellulose to add to the compositions of *Crotty*, one of ordinary skill would still not have been motivated to add the polyamides of *Pavlin* to the modified compositions of *Crotty*. Specifically, the hydroxylalkyl cellulose of *Crotty* is disclosed as a thickener, while the polyamide of *Pavlin* is disclosed as a gelling agent. See col. 4, lines 49-61 of *Crotty* and col. 1, lines 7-8. *Pavlin* does not teach or suggest the use of its polyamides in combination with other thickeners. Accordingly, one of ordinary skill in the art would not have been motivated to add both the gelling agent of *Pavlin* and the thickener of *Crotty* to the compositions of *Crotty*, as the Examiner apparently proposes, as these compositions are disclosed as useful for the same or similar purpose, and

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thus, including both would be duplicative, based on the teachings of *Crotty* and *Pavlin*. Again, as noted above, simply because references can be combined or modified does not render their combination obvious unless the references also suggest the desirability of the combination. See M.P.E.P. § 2143.01.

With respect to the second criterion the Examiner must demonstrate to establish a *prima facie* case of obviousness, *i.e.*, that there is a reasonable expectation of success in the proposed combination, the Examiner has again failed to meet his burden, as the references actually teach away from the combination the Examiner proposes. For example, *Pavlin* teaches that the polyamide disclosed therein "may be blended with a liquid hydrocarbon to form a transparent composition having gel consistency." See Abstract. *Crotty* does not disclose the use of liquid hydrocarbons in its compositions and, in fact, teaches that "[w]ater is a preferred vehicle or carrier" for its compositions. See col. 3, lines 21-22 and Example 1. Accordingly, the teachings of *Crotty* would have led the skilled artisan away from the combination the Examiner proposes, and therefore no reasonable expectation of success in the combination exists.

Finally, with respect to the Examiner's reliance on *Patel* for the teaching of galactomannan gum, Applicants first note that *Patel* is drawn to hair care products, such as shampoos. See col. 1, lines 4-27. However, *Crotty* is drawn to self-tanning creams for the skin. See Abstract. Accordingly, as these references disclose different compositions for different applications, one of ordinary skill in the art would neither be motivated to make the combination the Examiner proposes, nor have any reasonable

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expectation of success in such a combination, and in fact, the Examiner has not pointed to any such motivation on the record, as required by In re Lee, supra.

Moreover, one object of *Patel* is to "obtain a hair care composition which successfully incorporates a water insoluble non-volatile silicone into a composition." See col. 2, lines 15-17. The Examiner asserts that "it would have been obvious to include in the composition of *Crotty*...[the] conditioning agent of *Patel* in order to have a stable composition because otherwise [the] water insoluble silicone oil (in the composition of *Crotty*) makes that composition unstable." See page 3 of the present Office Action. However, the silicone in *Crotty*'s compositions is an anionic silicone copolyol and therefore is water soluble. See Abstract. Accordingly, the Examiner's reasoning is based on a technical error, and for at least this additional reason, the rejection should be withdrawn.

In light of the foregoing, Applicants respectfully submit that the Examiner has failed to establish a prima facie case of obviousness, and thus, request that the rejections under 35 U.S.C. § 103(a) be withdrawn.

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III. Conclusion

In view of the foregoing remarks, Applicants respectfully request the reconsideration of the pending claims, reexamination of the application, and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

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